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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bridget D. Kimball

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EXAMINER

DAVIS, ZACHARY A

ART UNIT

PAPER NUMBER

2437

NOTIFICATION DATE

DELIVERY MODE

08/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

Office Action Summary	Application No. 09/740,559	Applicant(s) KIMBALL ET AL.	
	Examiner Zachary A. Davis	Art Unit 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,10,12 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,10,12 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A reply was received on 21 April 2009. By this reply, Claim 9 has been amended. No claims have been added or canceled. Claims 9, 10, 12, and 27-29 are currently pending in the present application.

Response to Arguments

2. Applicant's arguments filed 21 April 2009 have been fully considered but they are not persuasive.

Regarding the rejection of Claims 9, 10, 12, and 27-29 under 35 U.S.C. 112, second paragraph, as indefinite, Applicant argues that there is proper antecedent basis to support that the references to "said set top box" and "the set top box" are the same as "a set top box" in the first limitation of the claim and that "it is clear that the term 'said set top box' refers to the set [sic] box which receives the rights message" and therefore the claims are not indefinite (see pages 4-5 of the present response). However, the Examiner respectfully disagrees. Again, the Examiner notes that there are plural set top boxes disclosed in Claim 9, noting that there is a recitation of "a set top box" in line 3 of the claim as amended and a subsequent recitation of "a plurality of separate set top boxes" in line 6. The claim clearly includes multiple set top boxes, and the Examiner again submits that any reference to "said set top box" or "the set top box" subsequent to the introduction of the plurality of separate set top boxes is unclear because it is not

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clear to which of the set top boxes, either the initial set top boxes or one of the separate set top boxes, the limitation “said [or the] set top box” is intended to refer. The claim still recites multiple set top boxes, and the limitation “said set top box” does not distinguish to which set top box it is intended to refer. Although Applicant has stated the intended meaning of the limitation, the actual language of the claims does not make that intent clear, and remains indefinite.

Regarding the rejection of Claims 9, 10, 12, and 27-29 under 35 U.S.C. 102(e) as anticipated by Safadi et al, US Patent 6256393, Applicant argues that the claimed rights message should not be equated to the EMM disclosed by Safadi, and also argues that the claimed authorization message should not be equated to the ECS disclosed by Safadi (page 6 of the present response).

More specifically, Applicant states that Safadi’s EMM “delivers the entitlement purchased by or granted to the consumer” and “is more like a key to open the lock of the access requirements” (page 6 of the present response, citing Safadi, column 3, lines 27-32 and 40-44). However, the Examiner fails to appreciate this distinction. The claim requires that the rights message “individually conveys access rights to said set top box for at least one functional unit in the set top box”; Safadi discloses that the EMM defines (i.e. conveys) authorization rights (i.e. access rights) for a particular (i.e. individually) set-top terminal (i.e. to said set to box) to access these services and associated objects (i.e. for at least one functional unit) (see Safadi, column 3, lines 23-25). Safadi further states that the EMM “delivers the entitlements” which is clearly analogous to conveying the access rights (i.e. what the user is entitled to access, see column 3, lines 41-43; see

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also column 6, line 38-column 7, line 2, as previously cited). Therefore, the Examiner submits that the EMM is equivalent to and can be equated to the claimed rights message.

Applicant also states that Safadi's ECS "contains access requirements for the object and the associated resources" and "is more like a key of the access requirements" (page 6 of the present response, citing Safadi, column 3, lines 27-32, and column 5, lines 40-44). However, the Examiner again fails to appreciate the distinction Applicant is attempting to draw. The claim requires that the authorization message "specifies required rights for use of a separately received software object by said set top box"; Safadi discloses that the ECS defines (i.e. specifies) access requirements (i.e. required rights) for a particular service and associated objects (i.e. for use of a software object) (see Safadi, column 3, lines 20-23). Safadi further states that the ECS "lists the entitlement information required" for program viewing or object use which is clearly analogous to specifying the required rights (i.e. what entitlements the user is required to have in order to be able to access the object, see column 3, lines 34-40; see also column 5, lines 30-50, as previously cited). Therefore, the Examiner submits that the ECS is equivalent to and can be equated to the claimed authorization message.

Applicant further argues that there is no description in Safadi of the newly added limitations pertaining to forming a signatory group and calculating a signature over the signatory group, or blocking access as a function of matching object identifiers and comparing a signature with a received signature (page 6 of the present response). However, the Examiner respectfully disagrees. Although the relevant portions may not

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have been cited in the previous Office actions, the Examiner submits that Safadi does disclose the limitations of matching object identifiers (for example, column 3, lines 25-27, where identification information is used to authenticate objects; see also column 4, lines 1-34, and column 7, line 66-column 8, line 31, where a fingerprint is formed based on an identifier and unauthorized objects will not have a fingerprint known to the set top box, and use of the unauthorized objects is not allowed) and forming a signatory group and calculating a signature over that group (column 5, lines 30-40, where a signatory group is formed and the group is signed), for example, as described in further detail below.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

Claim Objections

3. Although the amendments to the claims have corrected the informalities previously noted with respect to Claim 9 in the previous Office action, the amendments have raised further informalities as detailed below, and therefore the objection to Claim 9 is NOT withdrawn.

4. Claim 9 is objected to because of the following informalities:

Claim 9 recites “the object identifiers in the separately received software object” in lines 11-12 of the claim. It is noted that there was no prior reference to such object identifiers, and therefore, it appears that the article “the” should not be used in the first

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reference to these object identifiers. However, because it is clear that this is a reference to a separate set of identifiers, this does not raise an issue of indefiniteness.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation “said set top box” in lines 7, 8, and 9, and “the set top box” in lines 17-18. However, the claim also recites both “a set top box” in line 3 and “a plurality of separate set top boxes” in line 6. Because there are multiple set top boxes referred to, it is not clear to which of the set top boxes the limitation “said set top box” is intended to refer. This renders the claim indefinite. It is noted that the recitation of “said set top box” in lines 4 and 5 of the claim are not indefinite because there is only one set top box noted prior to these limitations. It is further noted that, for purposes of interpreting the prior art, the later limitations of “said set top box” are assumed to refer to the first mentioned set top box of lines 3 and not to the any of the plurality of separate set top boxes, as appears to have been Applicant’s intent (see also pages 4-5 of the present response). Claim 9 further recites “comparing the signature with a received

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signature” in line 20. However, the claim further refers to a calculated signature in line 15 and a received signature in line 16. Therefore, it is not clear to which signature “the signature” is intended to refer; further, it is not clear if “a received signature” in line 20 is intended to refer to the same received signature in line 16 or to a different received signature. This further renders the claim indefinite. For purposes of interpreting the prior art, “the signature” is assumed to refer to the calculated signature and the received signatures in lines 16 and 20 are assumed to refer to the same received signature.

Claims 10, 12, and 27-29 are rejected due to their dependence on rejected Claim 9.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Safadi et al, US Patent 6256393.

In reference to Claim 9, Safadi discloses a method that includes receiving a rights message with a set top box, where the rights message individually conveys

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access rights to the set top box for a functional unit (column 3, lines 23-25, 28-29, and 41-43; column 6, line 38-column 7, line 2, where the EMM conveys rights for software objects and terminal resources); receiving an authorization message with the set top box, where the authorization message is transmitted to a plurality of separate set top boxes and specifies required rights for use of a separately received software object by the first set top box (column 3, lines 20-23, 27-28, and 34-40; column 5, lines 30-50, where the ECS contains access requirements; column 5, line 64-column 6, line 12, where the ECS is sent to the set top boxes independently from the software objects); determining whether the first set top box is authorized to access the software object by comparing the access rights conveyed in the rights message with the required rights specified by the authorization message (column 3, lines 20-32; column 7, lines 19-26, where the access rights are compared with the authorization requirements); matching object identifiers in the authorization message with object identifiers in the software object (column 3, lines 25-27, where identification information is used to authenticate objects; column 4, lines 1-34, and column 7, line 66-column 8, line 31, where a fingerprint is formed based on an identifier and unauthorized objects will not have a fingerprint known to the set top box); forming a signatory group using the authorization message and the software object and calculating a signature over the signatory group (column 5, lines 30-40, where a signatory group is formed based on a previous fingerprint/signature of the object and also based on the ECS, i.e. authorization message, and the group is signed); comparing the signature with a received signature (see column 5, lines 30-40, regarding the calculation of the signature; see also column

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4, lines 1-34, where signatures are verified for authentication purposes); and blocking access by the set top box to the software object as a function of the determination of whether the set top box is authorized to access the software object, the matching of the object identifiers, and the signature comparison (column 3, lines 20-32, and column 7, lines 19-26, as above; see also column 7, lines 30-34, where the use of the object is only allowed if a check passes; column 9, lines 5-17, where use of the requested resource is disallowed if the EMM does not provide permission for use; see also column 7, line 66-column 8, line 31, where use is also not allowed when the fingerprint is not found, i.e. the object identifiers do not match).

In reference to Claim 10, Safadi further discloses blocking the software object by ignoring a portion of a datastream associated with the software object (see Figure 3, step 160, where the object is not utilized; see also column 7, lines 40-43 and 58-62; column 8, lines 11-16 and 20-25, where the object is not downloaded and/or utilized).

In reference to Claims 12 and 29, Safadi further discloses that the software object can include a software program or firmware (column 4, lines 1-4, where software objects can include applications or operating systems, *inter alia*; see also column 1, lines 9-16, where a software object can include BIOS, which is firmware).

In reference to Claims 27 and 28, Safadi further discloses that the software object can include video or audio content (column 4, lines 35-41, where audiovisual services are included).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/
Examiner, Art Unit 2437